

REMARKS

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 4, 6, 8 - 10, 12, 13, 15, 17 and 18 stand rejected under 35 U.S.C. §102(e) as being anticipated by Henson et al. (U.S. 6,167,383). As required by the Examiner in the Office Action, the material deleted from claims 1 and 10 has been crossed out in the claims recited above.

Amended independent claim 1, with underlining and italics used for emphasis, now recites:

"an interactive upsell advisor operatively coupled to said configurator, said database, and said cart for selectively providing an upsell recommendation to said cart as an ***upgrade now user selectable cart option on the cart web page, the upsell recommendation being selectively provided as a function of the prescribed customer set, the customer configured computer system, and prescribed upsell advisor business rules***, wherein said database dynamically supplies the prescribed upsell business rules to said upsell advisor, said upsell advisor utilizing the dynamically supplied prescribed upsell business rules in selectively providing upsell recommendations to said cart according to a sequencing of recommendations established per the upsell advisor business rules per store, further wherein ***upon a selection of the upgrade now user selectable cart option of said upsell advisor on the cart web page, said upsell advisor directly updates the customer configured computer system configuration per the upsell recommendation and provides a price reflecting acceptance of the upsell to the cart webpage.***"

The PTO provides in MPEP § 2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the patent must contain all of the claimed elements of claim 1.

However, a review of the Henson patent shows that the word "rule" appears nowhere in that patent. Moreover, the term "business rule" appears nowhere in that patent. Since the cited patent does not contain all of the elements recited in amended independent claim 1, a rejection of claim 1 for anticipation is improper. The same reasoning applies to amended independent claim 10. For these reasons, it is respectfully requested that the rejection of claim 10 under 35 U.S.C 102§ be withdrawn.

Dependent claims 3, 4, 6, 8, 9, 12, 13, 15, 17 – 24 depend from and further limit the allowable subject matter of independent claims 1 and 10 and therefore are believed to be allowable as well.

New apparatus claims 21 and 22 have been added to the patent application. These claims recite:

21. (New) The web-based online store of claim 1 wherein if after exiting the cart without accepting an upsell recommendation and upon later reentering that cart, a different upsell recommendation is offered.
22. (New) The web-based online store of claim 21 wherein a next upsell recommendation in a given priority order is displayed as the different upsell recommendation.

Since the subject matter recited in claims 21 and 22 is not disclosed in Henson, it is respectfully submitted that these claims are not anticipated by Henson and should thus

be allowed. Moreover, these claims depend on and further limit the allowable subject matter of independent claim 1 and should be allowed for this reason as well.

New apparatus claims 23 and 24 have been added to the patent application.
These claims recite:

23. (New) The method of claim 10 wherein if after exiting the cart without accepting an upsell recommendation and upon later reentering that cart, a different upsell recommendation is offered.

24. (New) The method of claim 23 wherein a next upsell recommendation in a given priority order is displayed as the different upsell recommendation.

Since the subject matter recited in claims 23 and 24 is not disclosed in Henson, it is respectfully submitted that these claims are not anticipated by Henson and should thus be allowed. Moreover, these claims depend on and further limit the allowable subject matter of independent claim 10 and should be allowed for this reason as well.

In view of the above, it is respectfully submitted that remaining claims 1, 3, 4, 6, 8 - 10, 12, 13, 15, 17 - 24 distinguish over the cited reference. Accordingly, the claims are in condition for allowance and an early Notice of Allowance is courteously solicited.

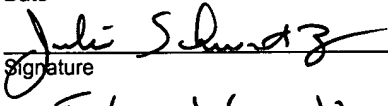
Respectfully submitted,



Mark P. Kahler
Registration No. 29,178

Dated: 4/29/2004
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 210/200-0853

A-162735.1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
on	<u>04/29/04</u>
Date	
Signature	
Julie Schwartz	
Typed or Printed name of person signing Certificate	